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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,070	01/23/2004	Ralph E. Kornbrekke	3282	8001

7590 07/13/2005

## THE LUBRIZOL CORPORATION

Patent Administrator  
Mail Drop 022B  
29400 Lakeland Boulevard  
Wickliffe, OH 44092-2298

EXAMINER
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SPECTOR, DAVID N

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

<b>Office Action Summary</b>	<b>Application No.</b> 10/764,070	<b>Applicant(s)</b> KORNBREKKE ET AL.	
	<b>Examiner</b> David N. Spector	<b>Art Unit</b> 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005 and 16 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-25 is/are rejected.
- 7) ☐ Claim(s) 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>0104/20040123</u> . | 6) <input checked="" type="checkbox"/> Other: <u>DETAILED ACTION</u> .                  |

## DETAILED ACTION

### *Status of the Application*

Applicant's election of Claims 1 and 3-23 (e.g. Group I, drawn to a structured fluid composition) in the reply filed on May 2, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claim 2 drawn to a non-elected invention was cancelled by applicant in the above-noted reply.

New claims 24 and 25 were added to the application as part of an amendment filed on June 16, 2005. Accordingly, claims 1 and 3-25 are now pending in the instant application.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1 and 3-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** In particular, independent claim (new) 1 is rendered indefinite by the recitation of "...more than one particle selected from the group consisting of a light absorbing particles, non light absorbing particles wherein the non light absorbing particles help to create a structured colloidal suspension..." (Claim 1, Lines 3-5; e.g. as amended on June 16, 2005). The reason the phrase is indefinite is that the aforesaid 'light absorbing particles' and 'non light absorbing particles' are apparently presented therein as alternative choices due to the comma used to delineate each one of the two types of particles; that is, the resulting 'more that one particle' can be interpreted as consisting of more than one light absorbing particle without any non light absorbing particles; or, alternatively, as consisting of more than one non light absorbing particle without any non light absorbing particles; both of which are inconsistent with the instant specification. Correction is required.

**Claims 1 and 3-25 are further rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which**

Art Unit: 2873

**applicant regards as the invention.** In particular, independent claim (new) 1 is rendered further indefinite by the recitation of "ink" (Claim 1, Line 7) therein without any antecedent basis. Correction is required.

**Claim 25 is further rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** In this case, claim 25 is rendered further indefinite by referring to "the composition of claim 2" in the preamble of the claim (e.g. Claim 2 drawn to a non-elected invention was cancelled by applicant). Correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Whitehead et al. (U.S. Patent No. 6,865,011).**

In regard to Claim 1 Whitehead et al. discloses a structured fluid composition comprising: a low refractive index liquid **22** (col. 2, ln. 42-43); more than one particle selected from the group consisting of a light absorbing particles **24** (col. 2, ln. 48-50 ); and a dispersant (col. 2, ln. 34-42); resulting in a stable suspension that is not agglomerated (col. 4, ln. 13-20), having ionically charged light absorbing particles, and forming an interactive structure which inhibits motion (col. 4, ln. 20-25), and for use in a TIR display (col. 2, ln. 47; **FIG. 3A-3B**). Claim 1 of the instant application is therefore anticipated by Whitehead et al.

In regard to Claim 3 Whitehead et al. discloses a structured fluid composition according to Claim 1 from which claim 3 depends, wherein the liquid electrophoretic medium **22** is comprised substantially fluorinated oils (col. 4, ln. 34-42). Claim 3 of the instant application is therefore anticipated by Whitehead et al.

Art Unit: 2873

***Allowable Subject Matter***

In the opinion of the examiner, the aforesaid rejections of applicant's claims under 35 U.S.C. 102(e) are primarily due to the indefiniteness discussed above in connection with the rejections of independent claim 1 herein under 35 U.S.C. 112, second paragraph.

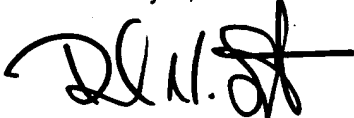
***Other Remarks/Information***

Figures 1-3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any other inquiry concerning this communication or earlier communications from the examiner should be directed to David N. Spector whose telephone number is (571) 272-2338. The examiner can normally be reached at this number Monday through Friday between 6:00 AM and 2:30 PM. The fax number for the organization where this application is assigned is (703) 872-9306.

July 8, 2005



DAVID N. SPECTOR  
PRIMARY EXAMINER